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SEP 18 2007

HP Docket No. 100110746-1

REMARKS

Applicant appreciates the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 15, 20, 30, and 31 have been amended. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC §112 Second Paragraph

Claims 1, 15, 20, and 31 "and their dependent claims, where applicable" (Office Action, p.3) have been rejected under 35 USC §112, paragraph 2, as being indefinite for failing to particularly point and distinctly claim the subject matter which the Applicant regards as the invention. In response, each of the stated reasons have been addressed in the foregoing claim amendments and are briefly summarized below.

Regarding the limitation of "without communicating with the one or more workflow processing devices", the Office states that the claim is unclear "because it is also stated that a communication interface is configured to receive a user request".

Claims 1 and 15, as amended, recite "processing circuitry configured to process the user request using the predefined rules data to produce a transformed user request without communicating with the one or more workflow processing devices". Claims 20 and 31, as

HP Docket No. 100110746-1

amended, recite that, without communicating with one or more workflow processing devices, predefined rules are executed to create a transformed user request.

Thus, what occurs without communicating with the workflow processing devices is the processing of a user request to form a transformed user request. The communication interface does communicate with the workflow processing devices with regard to the execution of the transformed user request, once it has been created, in order to generate the desired product. Such operation is described in the specification, for example, at para. [0030]-[0031], and at Fig. 4, steps 406-412. With regard to a §112, paragraph 2, rejection for lack of clarity, "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure" (MPEP 2173.02). In light of the above, Applicant respectfully believes that claims 1, 15, 20, and 31, as amended, are not unclear.

In addition, Applicant has also amended claims 1, 15, 20, 30, and 31 to remove the term "so as", as recommended by the Office.

In view of the foregoing, it is submitted that the rejections under 35 USC §112, paragraph 2, have been overcome and should be withdrawn.

Rejection Under 35USC §103

Claims 1-5, 15-17, 20, 22, 24, 26, and 30-31 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2002/0184240 to Volkoff et al. ("Volkoff") in view of U.S. patent 6,725,429 to Gardner ("Gardner"). Applicant respectfully traverses the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as

HP Docket No. 100110746-1

follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The rejection of independent claim 1, and its dependent claims 2-5, is respectfully traversed for at least the following reasons. Claim 1 recites:

"1. (Currently amended) A workflow management device comprising:
a communications interface configured to receive a user request comprising one or more user-desired product properties associated with a user-desired product, the interface further configured to communicate with one or more workflow processing devices located external of the workflow management device;
a storage device configured to store predefined rules data for processing the user request;
and
processing circuitry configured to process the user request using the predefined rules data to produce a transformed user request without communicating with the one or more workflow processing devices, the transformed user request including information for automatically organizing workflow among the one or more workflow processing devices in accordance with the one or more user-desired product properties to achieve the user-desired product via the one or more workflow processing devices." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

With regard to the limitation of the processing circuitry, the Office admits that the Volkoff reference "is silent with respect to processing circuitry configured to process the request using the predefined rules data and produce a transformed request without communicating with one or more workflow processing devices, the transformed request comprising information for automatically organizing ~~workflow through the system~~ in accordance with the one or more user-

HP Docket No. 100110746-1

desired product properties so as to produce a user-desired product” (Office Action, p.6).

However, the Office takes the position that the Gardner reference teaches this limitation at col. 8, lines 4-15. More specifically, as best understood by Applicant, the Office appears to state that the claim 1 limitation of “processing circuitry configured to process the request using the predefined rules data and produce a transformed request without communicating with one or more workflow processing devices” is taught by the Gardner reference as follows:

“The bill processing server, in turn, communicates with a router instruction processor which interacts with the electronic inserter, as well as informing the bill processing server of the generation of an electronic print stream associated with a bill and associated inserts for presentation to the interactive bill presentation server.” (col. 8, lines 4-9)

Furthermore, the Office appears to state that the claim 1 limitation of “the transformed request comprising information for automatically organizing workflow through the system in accordance with the one or more user-desired product properties so as to produce a user-desired product” is taught as follows:

“The interactive bill presentation server receives instructions from the customer via the Internet which, in turn, are communicated to the bill processing server for updating bill remittance data and the like, upon the customer indicating his or her desire to pay an associated bill received electronically. Bills are only made available to a customer when all necessary information for viewing has been pre-processed.” (col. 8, lines 9-15)

It is unclear to Applicant which elements of the reference the Office considers as corresponding to which elements of the claim. Absent this element mapping, Applicant can only guess at how the Office has determined that the Gardner reference teaches or suggests the limitation at issue. However, as best understood by Applicant, the element of a “user request comprising one or more user-desired product properties associated with a user-desired product” of claim 1 corresponds to a request from a service provider (e.g. a utility company) to produce and present an electronic bill for payment to a customer via the interactive bill presentation server. Next, as best understood, the Office appears to be stating that the “transformed user request including information for automatically organizing workflow among the one or more workflow processing devices in accordance with the one or more user-desired product properties”

HP Docket No. 100110746-1

to achieve the user-desired product” corresponds to the customer providing payment instructions to the interactive bill presentation server to pay the electronic bill. However, the transformation of such a “user request” to form a “transformed user request” involves communications between the bill processing server, the router instruction processor, the electronic inserter, the interactive bill presentation server, and the customer. Regardless of which of these is considered as corresponding to the workflow processing device(s), all of them are involved with the generation of a transformed user request. Thus the limitation of producing the transformed user request without communicating with the workflow processing devices is not satisfied.

Furthermore, the claim recites that both the user request and the transformed user request are directed to the same user-desired product having user-desired product properties. However, the Gardner reference fails to teach or suggest this, because the transformed user request is directed to a different product than the user request. More specifically, the user-desired product associated with the user request is an electronic bill (plus inserts), while the user-desired product associated with the transformed user request is a payment.

Therefore, for the reasons discussed above, the applied references do not teach or suggest all of Applicant’s claim limitations. If Applicant has misunderstood the Office’s position with regard to the Gardner reference, and the Office maintains the rejection on the same references, it is respectfully requested that the Office, pursuant to 37 CFR §1.104(c)(2), point out in a subsequent non-final Office Action the features in the references that allegedly correspond to the limitations of the claims, by providing an element mapping between the claim and the reference that will allow Applicant to better address the rejection.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no articulated reason with some rational underpinning that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. In Re Kahn, 441 F.3d, 977, 988 (CA Fed. 2006). The Office states that a “skilled artisan would have been motivated to combine as suggested by Gardner [column 2, lines 57-62] for

HP Docket No. 100110746-1

establishing an improved method for rerouting information to be processed and presented" (Office Action, p.7). Applicant does not believe that the cited portion of the Gardner reference provides any suggestion or motivation to combine. The cited portion merely provides a summary of interactions among various subsystems that are performed by the system of the Gardner reference:

"A router instruction processor (RIP) receives "send requests" messages from the electronic inserter and generates "bill request" therefrom. Each bill request is sent to a bill processing server (BPS). The RIP is responsible for collecting status information regarding the bill to be processed, as well as to make such information available to the submitting process." (col. 2, lines 57-62)

As such, the reason provided by the Office is merely a recitation of features of the Gardner reference. The cited section of the Gardner reference provides no suggestion or motivation to combine, and thus lacks the rational underpinning required for validly combining the references. Consequently, this rationale impermissibly uses the Applicant's disclosure as a blueprint or in hindsight for the rejection. Accordingly, there is no suggestion or motivation to modify the reference or to combine reference teachings.

In addition, the Volkoff and Gardner references are directed to significantly different problems, and provide significantly different solutions. The Volkoff reference is directed to "a job ticket service that allows access and modification of a job ticket by multiple users on a network" (para. [0005]). The job ticket may include specific requirements of a printing order specified by a user, such as paper type, font size, layout, graphics, and color (para. [0002]-[0003]). Use of the job ticket allows various printing services and resources on the network that are best suited to produce printed output having the specified requirements to be allocated to the job (para. [0004]). The Gardner reference, conversely, is directed to "a digital document delivery system ... particularly for presentation of electronic bills to a customer with a mechanism for payment thereof by the customer" (col. 2, lines 31-36). However, a fixed set of "four subsystems which typically execute on four separate servers" – a print stream separator/electronic inserter, a router instruction processor (RIP), a bill processing server (BPS), and an interactive bill presentation server (IBPS) – generate and present the bills from the utility to the customer, and receive the customer's instructions and

HP Docket No. 100110746-1

commands regarding whether and how to make payment (col. 2, line 43 – col. 3, line 29). Thus, combining the Gardner reference with the Volkoff reference would destroy the purpose of the primary reference. “If references taken in combination would produce a ‘seemingly inoperative device’, we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness” *McGinley v. Franklin Sports Inc.*, 60 *USPQ2d 1001, 101 (Fed. Cir. 2001)*. Here, using a fixed set of network resources as taught by the Gardner reference would destroy the ability of the Volkoff reference to choose from among the network resources only the best printing resources and services to print the product defined by the job ticket. Thus, the references teach away from the combination or modification proposed by the Office

Applicant respectfully traverses the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants’ invention. Because the Office has not provided an articulated reason with some rational underpinning to combine the prior art elements in the manner claimed, and because the references teach away from the combination, it is improper to combine the Volkoff and Gardner references and the rejection under 103(a) should be withdrawn.

Independent claims 15, 20, 30, and 31 each recite limitations similar to those of claim 1, discussed above, including the limitation of “without communicating with one or more workflow processing devices”. With regard to the teachings of the Gardner reference, the rejections for these claims refer Applicant to the rejection of claim 1. Therefore, for similar reasons as explained heretofore with regard to claim 1, the features of the present invention are not taught or suggested by the cited references in that at least these features are neither taught nor suggested by the cited references in combination, and the references cannot be properly combined. Applicant respectfully traverses the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicant’s invention. Such could be possible only in hindsight and in light of

HP Docket No. 100110746-1

Applicant's teachings. Therefore, the rejection of independent claims 15, 20, 30, and 31, and their corresponding dependent claims 16-17, 22, 24, and 26, is improper at least for that reason and should be withdrawn.

Claims 6-9, 18-19, 21, 23, 25-26, and 32-33 have been rejected under 35 USC §103(a), as being unpatentable over Volkoff in view of Gardner, and further in view of U.S. patent application publication 2002/0184240 to Volkoff et al. ("Volkoff") in view of U.S. patent 6,507,857 to Yalcinalp ("Yalcinalp"). Applicant respectfully traverses the rejection and requests reconsideration at least based on the dependence of these claims on one of independent claims 1, 15, 20, 30, and 31, whose reasons for allowability over the Volkoff and Gardner references have been discussed heretofore and against which the Yalcinalp reference has not been cited. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

In addition, dependent claim 32 is patentably distinguishable over the cited references for further reasons. Claim 32 recites:

"32. (Previously presented) The device of claim 9, wherein each stylesheet corresponds to a different subset of the product properties." (emphasis added)

In rejecting claim 32, the Office admits that the combination of the Volkoff and Gardner references does not teach this limitation, but takes the position that "Yalcinalp teaches wherein each stylesheet corresponds to a different subset of the product properties (Figure 2, all features, wherein the style sheet corresponds with the XSLT processor components, Yalcinalp)" (Office Action, p.20). Fig. 2 of the Volkoff reference "is a node tree diagram ... 10 that illustrates processes defined in a job ticket for printing a brochure". (para. [0028]).

However, it is evident from Fig. 2 of the Yalcinalp references that stylesheets 220 are different elements than components 225. With regard to different stylesheets 220, the Yalcinalp reference teaches merely that a user requests a document having an associated style sheet (Fig. 3, step 300). There is no teaching or suggestion in the Yalcinalp reference, alone or in combination

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SEP 18 2007

HP Docket No. 100110746-1

with the Volkoff and Garnder references, that each of the associated style sheets 220 corresponds to a different subset of product properties of the user request. Such an interpretation impermissibly relies on hindsight and uses the Applicant's disclosure as a blueprint for the rejection. Therefore, the rejection of claim 32 is improper for this additional reason.

Also, dependent claim 33 is patentably distinguishable over the cited references for further reasons. Claim 33 recites:

"33. (Previously presented) The device of claim 32, wherein the transformed user request generated by a first one of the stylesheets has a different workflow than the transformed user request generated by a second one of the stylesheets." (emphasis added)

In rejecting claim 33, the Office admits that the combination of the Volkoff and Gardner references does not teach this limitation, but takes the position that the "document request and transformed document is generated through the components contained in the XSLT processor which includes validation, XML parser, stylesheet and external component processing and XML document builder" (Office Action, p.21).

To whatever extent this is accurate, however, the Office points out nothing in the references that teaches or suggests that the transformed user request generated by a first one of the stylesheets has a different workflow than the transformed user request generated by a second one of the stylesheets. Applicant believes that such is not taught by the Yalcinalp reference, alone or in combination with the Volkoff and Gardner references. Any such interpretation impermissibly relies on hindsight and uses the Applicant's disclosure as a blueprint for the rejection. Therefore, the rejection of claim 33 is improper for this additional reason.

Conclusion

Attorney for Applicant has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application are patentably ~~distinct from the prior art~~

HP Docket No. 100110746-1

distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

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SEP 18 2007

HP Docket No. 100110746-1

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Respectfully submitted,



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